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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,563	10/23/2003	Frederic Legrand	05725.1255-00	6452

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EXAMINER	
VENKAT, JYOTHSNA A	

ART UNIT	PAPER NUMBER
1615	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/690,563	LEGRAND, FREDERIC	
	Examiner	Art Unit	
	JYOTHSNA A. VENKAT Ph. D	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 March 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-71* is/are pending in the application.

4a) Of the above claim(s) *60-71* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-59* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/23/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of election and IDS filed on 3/16/07 and 10/23/03.

Due to an inadvertent typographical error claims 70-71 were included in group IV. This error is regretted. Claims 68-69 belong to group IV and claims 70-71 belong to group V.

Claims 1-71 are pending in the application and the status of the application is as follows:

Information Disclosure Statement

The foreign patents, which are not in English language has been considered to the extent that it reads only on the abstracts or corresponding U. S. Patents only.

Election/Restrictions

Applicant's election with traverse of group I in the reply filed on 3/16/07 is acknowledged. The traversal is on the ground(s) that all Groups I-IV relate to an oxidizing emulsion and therefore, examining all claims of Groups I-IV, especially all claims of Groups I-IV, together would not impose a serious burden. This is not found persuasive because inventions I and II-IV are related as product and process of use, and the product as claimed is used in three distinct process and the restriction is in compliance with MPEP § 806.05(h). The requirement is still deemed proper and is therefore made FINAL.

Claims 60-71 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 3/16/07.

Applicanst are notified that election of species is withdrawn. Claims 1-69 are pending in the application and the status of the application is as follows:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-11, 34-37, and 39-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patent 4,927,627 ('627) and U. S. Patent 6,287,543('543) or combination of U. S. Patent 4,927,627 ('627) and 6,630,131('131).

Claim analysis

Claims recite amphilic polymer of formula I and at least one hydrophobic unit comprising form 6-50 carbon atoms. Patents '543 and '131 teaches amphilic polymer of formula I and ethylenic monomer of formula II, and formula II meets the claim requirement of hydrophobic unit.

Patent '627 teaches hydrogen peroxide emulsions for bleaching hair. Patent teaches at col.2, lines 34-45 teaches hydrogen peroxide in the form of oil-in-water (o/w) emulsions and at

col.3, line 18 teaches the concentration of the hydrogen peroxide, which is the oxidizing agent claimed. Patent at col.2, lines 51-65 teach anionic and nonionic surfactant and mixture of these surfactants. See also col.3, lines 8-17. Patent at col.2, lines 56-50 teaches the claimed fatty alcohols and in examples teaches cetyl alcohol claimed. Patent at col.3, under 9f) teaches claimed stabilizers and under (g) teaches adding buffer agents so that pH is between 3-5. See examples for additives. The difference between the patent '627 and the instant application is patent does not teach having amphilic polymer and the hydrophobic unit.

However patent '543 teaches compositions in the form of emulsion using cross-linked amphilic polymer. See the abstarcat, see col.1, lines 8-20, see col.2, for formula I claimed and see col.3, lines 24-37 for the hydrophobic unit and see col.3, lines 17-23 for the cross linking agent. Patent at col.10, lines 7-10 teach that the polymer can be used as cream for hair.

Patent '131also teaches amphilic polymer of formula hydrophobic unit and I. See the abstract. Patent at col.1, under " summary of the invention" teaches that the polymer derived form formula provides stability over time for emulsions. See col.3, lines 32 through col.4, lines 10. See col.4, lines 11-33 for cross-linking agents that can be used and also the hydrophobic unit. See also col.5, lines 1-7. See col.7, lines 39-42 for o/w emulsions and see the penultimate paragraph for the emulsifiers that can be added.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the compositions of '627 which is o/w emulsion having oxidizing agent, surfactant, stabilizer, fatty alcohol and combine it with amphilic polymer of formula I and hydrophobic unit since patents ''543 teaches that this polymer can be used in cream (emulsions)

for hair and patent '131also teaches that this polymer provides stability to emulsions. This is a prima facie case of obviousness.

Claims 1-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patent 4,927,627 ('627) and U. S. Patent 6,902,722('722) or combination of U. S. Patent 4,927,627 ('627) and 6,955,803(''803) combination of U. S. Patent 4,927,627 ('627) and 7,045,120 ('120).

The filing date of the instant application is 10/23/03 since the provisional application is in French language. All the patents are competent references based upon the filing date.

Patent '627 teaches hydrogen peroxide emulsions for bleaching hair. Patent teaches at col.2, lines 34-45 teaches hydrogen peroxide in the form of oil-in-water (o/w) emulsions and at col.3, line 18 teaches the concentration of the hydrogen peroxide, which is the oxidizing agent claimed. Patent at col.2, lines 51-65 teach anionic and nonionic surfactant and mixture of these surfactants. See also col.3, lines 8-17. Patent at col.2, lines 56-50 teaches the claimed fatty alcohols and in examples teaches cetyl alcohol claimed. Patent at col.3, under (f) teaches claimed stabilizers and under (g) teaches adding buffer agents so that pH is between 3-5. See examples for additives. The difference between the patent '627 and the instant application is patent does not teach having amphilic polymer and the claimed hydrophobic unit.

However patent '722 teaches compositions in the form of emulsion using claimed cross-linked amphilic polymer and claimed hydrophobic unit. See the abstract, see col.5, lines 55 et seq for the claimed amphiphilic polymer of formula I and see col.6, lines 1-20 for formula II, which is the claimed hydrophobic unit of formula III. See col.8, lines 43-45 for o/w emulsions.

Patent teaches that the polymer can be used in skin, nail or hair compositions (keratin containing compositions).

Patent '120 also teaches amphilic polymer of formula I and hydrophobic unit. See the abstract. See cols. 3-6 for the amphilic polymer formed from formula I and formula III (claimed). Formula III claimed is the species belonging to formula II. See col.8, lines 28-33. Patent teaches that this polymer can be used in skin or hair compositions (keratin containing compositions).

Patent '803 also teaches amphilic polymer of formula I and hydrophobic unit. See the abstract. See cols. 3-6 for the amphilic polymer formed from formula I and formula III (claimed). Formula III claimed is the species belonging to formula II. See col.7, last paragraph. Patent teaches that this polymer can be used in skin or hair compositions (keratin containing compositions).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the compositions of '627 whcih is o/w emulsion having oxidizing agent, surfactant, stabilizer, fatty alcohol and combine it with amphilic polymer of formula I and hydrophobic unit since patents '722 '120, and '803 teaches that this polymer can be used in cream (emulsions) for hair. This is a prima facie case of obviousness.

Claims 1-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. patent '627 and PGPUB 20040074015 (PGPUB '015).

Patent '627 teaches hydrogen peroxide emulsions for bleaching hair. Patent teaches at col.2, lines 34-45 teaches hydrogen peroxide in the form of oil-in-water (o/w) emulsions and at col.3, line 18 teaches the concentration of the hydrogen peroxide, which is the oxidizing agent claimed. Patent at col.2, lines 51-65 teach anionic and nonionic surfactant and mixture of these

surfactants. See also col.3, lines 8-17. Patent at col.2, lines 56-50 teaches the claimed fatty alcohols and in examples teaches cetyl alcohol claimed. Patent at col.3, under (f) teaches claimed stabilizers and under (g) teaches adding buffer agents so that pH is between 3-5. See examples for additives. The difference between the patent '627 and the instant application is patent does not teach having amphilic polymer and the claimed hydrophobic unit.

However PGPUB '015 teaches oxidizing compositions using claimed cross-linked amphilic polymer and claimed hydrophobic unit. See the abstract, see paragraph 8 for the oxidizing agent, which includes hydrogen peroxide. See paragraph 9 for surfactant, see paragraphs 27-88 for detailed description of the claimed amphilic polymer and claimed hydrophobic unit. See paragraphs for detailed description of the oxidizing agent and see paragraph 97 for the claimed stabilizer, see paragraphs 218-220 for anionic and non-ionic surfactants.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the compositions of '627 whcih is o/w emulsion having oxidizing agent, surfactant, stabilizer, fatty alcohol and combine it with amphilic polymer of formula I and hydrophobic unit expecting beneficial effect. One of ordinary skill in the hair care art would be motivated to add the amphiphilic polymer with the reasonable expectation of success that the amphiphilic polymer provides storage stability which is beneficial to the consumer. This is a prima facie case of obviousness.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection

is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-59 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-57 and 63-75 of copending Application No. 10/451,409 in view of U. S. Patent 4,927,627.

The instant application is claiming emulsion comprising oxidizing agent, surfactant, fatty alcohol and amphiphilic polymer and stabilizer. Copending application is also claiming oxidizing composition comprising oxidizing agent and amphiphilic polymer with hydrophobic unit and stabilizer. Co-pending application is claiming genus belonging to " amphiphilic polymer" and also the same amphiphilic polymer claimed in the instant application. Thus the genus claims in the co-pending application anticipates the species and when the claims are to species belonging to amphiphilic polymer in the co-pending application then both are same. Copending application is not to emulsions, but to compostions and copending application is not claiming fatty alcohol or surfactant. However patent teaches oil in water emulsions using hydrogen peroxide, fatty alcohol and surfactant. One of ordinary skill in the art would prepare compositions of 10/451,409 and add fatty alcohol and surfactant and use in the form of emulsions expecting that the emulsions

are stable over long time in view of the amphiphilic polymer and the emulsions also exhibit improved depth of brightness.

This is a provisional obviousness-type double patenting rejection.

Claims 1-59 are directed to an invention not patentably distinct from claims 1-57 and 63-75 of commonly assigned 10/451,409 in view patent '627. Specifically, for the reasons stated in the obviousness-type double patenting rejection.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 10/451,409, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is

571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JYOTHSNA A VENKAT Ph. D
Primary Examiner
Art Unit 1615

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